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| 09/592,618 | 06/13/2000 | Jay S. Walker | 00-012 | 5604 |

22927 7590 10/03/2002

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EXAMINER

BORISSOV, IGOR N

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,618

Applicant(s)

WALKER ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "said transaction information" lacks antecedent basis.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-64 are rejected under 35 U.S.C. 101 because the claimed method for referring postings does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). The independently claimed steps of: receiving information relating to a first transaction; determining a benefit, said benefit based at least in part on said information; determining a price for said benefit; and applying said benefit during a second transaction, are abstract ideas which can be performed mentally without interaction of a physical structure or are mere data storage devices that do not implement a useful, concrete and tangible result of a machine. Because the independently claimed invention is directed to an abstract idea which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6-9, 11-23, 28-29, 30-33, 35-38, 40-44, 46 and 47-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams (US 2002/0049631).

Williams teaches a method, system and computer readable medium for providing purchasing incentives to a plurality of retail store environments, comprising:

As per claims 1, 13-15, 18-22, 30, 46-50, 52-57 and 65-69,

- receiving information relating to a first transaction (Abstract; [0020]; [0047] through [0055]);
- determining a benefit, said benefit based at least in part on said information (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);
- determining a price for said benefit (Abstract; [0037]); and
- applying said benefit during a second transaction (Abstract; [0063]).

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As per claims 2 and 32, said method, system and computer readable medium, further comprising at least one of the following: retrieving benefit information; offering said benefit for sale at said price; receiving an indication of a purchase of said benefit; and receiving an indication of a customer's agreement to purchase said benefit (Abstract; [0021] through [0024]; [0037] through [0039]).

As per claims 3 and 33, said method, system and computer readable medium, further comprising at least one of the following: determining an available subsidy; receiving a subsidy amount; and determining a margin between a price and a subsidy amount ([0039]; [0040]; [0051]; [0052]).

As per claims 4 and 31, said method, system and computer readable medium, further comprising:

- verifying usability of said benefit during said second transaction ([0013] through [0015]; [0020] through [0022]; [0037] through [0039]).

As per claims 6 and 35, said method, system and computer readable medium, further comprising at least one of the following: establishing a condition on said benefit; determining a condition associated with said benefit; and providing an indication of a condition associated with said benefit ([0020] through [0022]).

As per claims 7 and 36, said method, system and computer readable medium, further comprising at least one of the following: receiving an indication of a receiver of said benefit; canceling said benefit; changing said benefit; and redeeming said benefit ([0020] through [0022]).

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As per claims 8 and 37, said method, system and computer readable medium, further comprising at least one of the following: receiving a customer identifier; receiving a group identifier; receiving a customer device identifier; receiving a payment identifier; receiving a retailer identifier; receiving a benefit identifier; receiving a service identifier; and receiving a product identifier (Abstract; [0012]; [0020] through [0027]; [0031] through [0035]).

As per claims 9, 19 and 38, said method, system and computer readable medium, further comprising at least one of the following: redeeming a previously determined benefit; receiving a request to redeem said benefit; aggregating said benefit with a previously determined benefit ([0006]; [0019]; [0022]).

As per claims 11-12 and 40, said method, system and computer readable medium, further comprising: providing a list of at least two benefits; receiving an indication of a selection of one of said at least two benefits; receiving an indication of at least one person to whom said benefit is to be provided (Abstract; [0014]; [0021] through [0024]; [0037] through [0039]).

As per claims 16-17 and 42-44, said method, system and computer readable medium, further comprising:

- receiving an indication of a completion of said qualifying action ([0021]; [0022]; [0024]; [0038]);
- providing said benefit after receiving said indication ([0021]; [0022]; [0024]; [0038]);
- arranging for said benefit to be provided after receiving said indication ([0021]; [0022]; [0024]; [0038]).

As per claim 23, said method, system and computer readable medium, wherein said benefit is based at least in part on at least one of the following: a customer identifier; a group

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identifier; -a benefit identifier; preference information for a customer; credit history of a customer; a characteristic of a customer; customer demographic information; a history of a customer at a retailer; information regarding a customer's brand loyalty; information regarding a customer's brand indifference; a product; a service; a previously determined benefit; a previously determined but unredeemed benefit; a previously determined price for a previously determined benefit; a total of a plurality of previously determined benefits; a quantity of a product in inventory; a subsidy amount; brand-loyalty of a customer; brand-indifference of a customer; an amount of change due a customer as a result of said transaction; product quantity information; a price for a collection of products; a price for a collection of services; a price for a product; and a price for a service (Abstract; [0037]).

As per claim 28, said method, system and computer readable medium, wherein said benefit cannot be applied during said first transaction ([0022]).

As per claim 29, said method, system and computer readable medium, wherein said price determined for said benefit is zero (Abstract; [0037]).

As per claim 51, said method, system and computer readable medium, comprising:

- receiving information relating to a first transaction (Abstract; [0020]; [0047] through [0055]);
- determining a benefit, said benefit based at least in part on said information and having an associated price (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);
- providing said benefit at said price during said first transaction (Abstract; [0037]); and

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- applying said benefit during a second transaction, wherein said benefit is applicable by a customer during said second transaction only if said customer has completed a qualifying action associated with said benefit (Abstract; [0038]; [0063]).

As per claim 58, said method, system and computer readable medium, comprising:

- determining a benefit identifier (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);

- retrieving benefit information associated with said benefit identifier (Abstract; [0037] through [0039]);

- verifying usability of said benefit during a transaction ([0013] through [0015]; [0020] through [0022]; [0037] through [0039]); and

- applying said benefit during said transaction ([0063]).

As per claims 59-62, said method, system and computer readable medium, comprising:

- determining at least one product being purchased by a customer during a first transaction (Abstract; [0020]; [0047] through [0055]);

- determining a price for said at least one product being purchased during said first transaction (Abstract; [0020]; [0047] through [0055]);

- offering said customer an opportunity to purchase said at least one product during a second transaction at said price (Abstract; [0021] through [0024]; [0037] through [0039]);

- receiving an acceptance of said offer from said customer (Abstract; [0021] through [0024]; [0037] through [0039]);

- allowing said customer to purchase said product during said second transaction for said price (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

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- providing said customer a benefit identifier associated with said at least one product (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);
- receiving said benefit identifier during said second transaction (Abstract; [0012]; [0013] through [0015]; [0020] through [0027]; [0031] through [0039]);
- determining a benefit based on said benefit identifier (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]).

As per claims 63-64, said method, system and computer readable medium, comprising:

- determining at least one product being purchased by a customer during a first transaction (Abstract; [0020]; [0047] through [0055]);
- determining a price for said at least one product being purchased during said first transaction (Abstract; [0020]; [0047] through [0055]);
- providing said customer a benefit during said first transaction, wherein said benefit allows said to purchase said at least one product during a second transaction at said price (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]); and
- allowing said customer to purchase said product during said second transaction for said price (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

As per claims 70-71, said method, system and computer readable medium, comprising:

- computer readable means for obtaining transaction information (Abstract; [0020]; [0047] through [0055]);
- computer readable means for identifying a benefit and a qualifying action associated with said benefit, said benefit based at least in part on said transaction information (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);

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- computer readable means for identifying a price for said benefit (Abstract; [0037]);
- computer readable means for providing said benefit for sale at said price (Abstract; [0037] through [0039]); and
- computer readable means for using said benefit during a new transaction (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

As per claims 72, 76 and 80, said method, system and computer readable medium, comprising:

- means for obtaining transaction information (Abstract; [0020]; [0047] through [0055]);
- means for identifying a benefit and a qualifying action associated with said benefit, said benefit based at least in part on said transaction information (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);
- means for identifying a price for said benefit (Abstract; [0037]);
- means for providing said benefit for sale at said price; and means for using said benefit during a new transaction (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

As per claims 73-77, said method, system and computer readable medium, comprising a memory, a communication port, and a processor connected to said memory and said communication port, said processor being operative to:

- receive information associated with a first transaction (Abstract; [0020]; [0047] through [0055]);
- establish a benefit having a price and associated with said first transaction (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);

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- provide said benefit at said price during said first transaction (Abstract; [0021] through [0024]; [0037] through [0039]); and

- apply said benefit during a second transaction (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

As per claims 74-75, said method, system and computer readable medium, comprising:

- computer readable means for obtaining information associated with a first transaction (Abstract; [0020]; [0047] through [0055]);

- computer readable means for determining a benefit having a price and associated with said first transaction (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);

- computer readable means for providing said benefit at said price during said first transaction (Abstract; [0021] through [0024]; [0037] through [0039]); and

- computer readable means for using said benefit during a second transaction (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

As per claims 78-79, said method, system and computer readable medium, comprising:

- computer readable means for transmitting information relating to an initial transaction (Abstract; [0020]; [0047] through [0055]);

- computer readable means for obtaining an indication of a benefit (Abstract; [0013] through [0015]; [0020] through [0022]; [0037] through [0039]);

- computer readable means for obtaining an indication of a price for said benefit (Abstract; [0021] through [0024]; [0037] through [0039]);

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- computer readable means for obtaining said benefit at said price (Abstract; [0021] through [0024]; [0037] through [0039]); and
- computer readable means for using said benefit during a later transaction (Abstract; [0021] through [0024]; [0037] through [0039]; [0063]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 24-25, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Walker et al. (US 5,970,470).

As per claims 5, 10, 34 and 39, Williams teaches all the limitations of claims 5, 10, 34 and 39, except imposing a penalty or reducing the benefit if a customer does not complete a specific future transaction.

Walker et al. teach a method and system for establishing and managing subscription purchase agreements, wherein a customer's account may be assessed a penalty in the event that the customer does not honor the purchase terms and conditions (Abstract; column 2, line 48 through column 3, line 6).

It would have been obvious to one having ordinary skill in the art to modify Williams to include imposing a penalty if a customer does not complete a specific future transaction because

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it would increase the profitability of the system by decreasing the losses incurred by vendors providing benefits for their customers.

As per claims 24-25, Walker et al. teach said method and system, further comprising providing a receipt to a customer, wherein said receipt includes at least one of the following: a customer identifier; a benefit identifier; a group identifier; a transaction identifier; a product identifier; a service identifier; a payment identifier; a retailer identifier; a code indicative of said benefit; indicia indicative of said benefit; indicia indicative of a condition associated with said benefit; indicia indicative of a qualifying action associated with said benefit; a code indicative of said price; indicia indicative of said price; said price; said benefit; and at least part of said information relating to said first transaction (column 15, line 26 through column 16, line 20).

Claims 26-27 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Mindrum et al. (US 4,723,212).

As per claims 26-27 and 45, Williams teaches all the limitations of claims 26-27 and 45, except that the benefit is transferable, and wherein said benefit can be shared by a plurality of people.

Mindrum et al. teach a method and apparatus for dispensing discount coupons, wherein said coupons are distributed to different groups of customers (Abstract; column 1, lines 25-54).

It would have been obvious to one having ordinary skill in the art to modify Williams to include that the benefit is transferable and can be shared by a plurality of people because it would increase the profitability of the system by attracting new customers.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

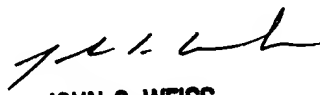
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


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